

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

NEONODE SMARTPHONE LLC., <i>Plaintiff,</i>	§ § § § § § § § § §	Civil Action No. 6:20-cv-00507-ADA
v.		
SAMSUNG ELECTRONICS CO. LTD. AND SAMSUNG ELECTRONICS AMERICA, INC., <i>Defendants.</i>		JURY TRIAL DEMANDED

**JOINT MOTION TO LIFT STAY PURSUANT TO THIS COURT’S AUGUST 11, 2021
ORDER**

As instructed in this Court’s April 22, 2022 Order staying this case, plaintiff Neonode Smartphone LLC (“Neonode”) and defendants Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”) hereby jointly move to lift the stay.

In this action, Neonode alleges that Samsung has infringed and is infringing U.S. Patent No. 8,812,993 (“the ‘993 Patent”) and U.S. Patent No. 8,095,879 (“the ‘879 Patent”).

On November 6, 2020, Apple Inc. (“Apple”) and Samsung (collectively, “Petitioners”) jointly filed IPR2021-00144 against the ‘879 Patent and IPR2021-00145 against the ‘993 Patent.

On August 11, 2021, Neonode and Samsung filed a Stipulation to Stay Case Pending Final Written Decisions in Certain Inter Partes Review Proceedings. Dkt. 51. Pursuant to this filing, Neonode and Samsung stipulated to stay this case, with the exception of any work related to discovery in Sweden, pending the final written decision in IPR2021-00145 and, if rehearing was granted in IPR2021-00144, a final written decision in IPR2021-00144. *Id.* Subsequently, the Patent Trial and Appeal Board (“PTAB”) granted rehearing in IPR2021-00144.

On April 22, 2022, this Court entered an order granting the parties' stipulation and staying this case "pending the final written decision in IPR2021-00145 and, if rehearing is granted in IPR2021-00144, a final written decision in IPR2021-00144." Dkt. 55. The Court ordered that "[t]he parties shall file a joint motion to lift the stay within one week of the stay condition becoming fulfilled." *Id.*

On June 15, 2022, the PTAB issued a final written decision in IPR2021-00145, finding that Apple and Samsung had shown that claims 1-8 of the '993 Patent are unpatentable.

On December 1, 2022, the PTAB issued a final written decision in IPR2021-00144, finding that "claims 1–6 and 12–17 of the '879 patent have not been shown to be unpatentable."

On December 9, 2022, the parties filed a Joint Status Report Regarding IPR Proceedings in which they informed the Court of the final written decisions issued by the PTAB. Dkt. 62. The parties also informed the Court that a second IPR had been filed against the '879 Patent by Google LLC, IPR2021-01041, and that a final written decision was due to be issued in that proceeding by no later than January 13, 2023. *Id.* Given that a final written decision was due to be issued in IPR2021-01041 little more than one month later, the parties jointly requested that the Court extend the stay through issuance of a final written decision in IPR2021-01041. *Id.*

On January 11, 2023, the PTAB issued a final written decision in IPR2021-01041, finding that petitioner Google had failed to show that any claims of the '879 Patent are unpatentable.

Accordingly, because final written decisions have been issued in IPR2021-00144, IPR2021-00145, and IPR2021-01041, the stay conditions have been fulfilled.

Neonode's Position: The stay conditions have been satisfied. The claims of the '879 Patent have been challenged in two IPRs, and none have been found to be unpatentable. The Court

should therefore lift the stay and order that the parties submit a proposed scheduling order within one week of entry of the order on this motion. The Court should enter Neonode's version of the Proposed Order Granting Motion to Lift Stay, which includes instructions to submit a proposed scheduling order, attached hereto as Attachment 1.

Samsung's Position: The PTAB found all claims of the '993 patent unpatentable in IPR2021-00145. Neonode filed a Notice of Appeal from that decision on August 15, 2022. IPR2021-00145, Paper No. 74. On December 1, 2022 the PTAB issued a decision finding claims 1-6 and 12-17 of the '879 patent are not unpatentable based on the instituted grounds of unpatentability. Samsung and Apple (co-Petitioners) have 63 days from December 1, 2022 to file a notice of appeal. Samsung intends to appeal the PTAB's findings for the '879 patent and seek a further stay of this case pending appeal of the final written decisions in the IPRs. The Court should enter Samsung's version of the Proposed Order Granting Motion to Lift Stay, attached hereto as Attachment 2.

Respectfully submitted,

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***ATTORNEYS FOR SAMSUNG ELECTRONICS
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CERTIFICATE OF SERVICE

I certify that the foregoing document was filed electronically on January 18, 2023, pursuant to Local Rule CV-5(a) and has been served on all counsel who have consented to electronic service via electronic mail. Any other counsel of record will be served by first class U.S. mail on this same date.

\s\ Philip J. Graves
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